



TTAB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PRAMIL S.R.L. (ESAPHARMA),  
Petitioner,  
vs.  
MICHEL FARAH,  
Registrant.

76058821  
Cancellation No. 92032341

**PETITIONER'S RESPONSE TO REGISTRANT'S PETITION TO**  
**THE DIRECTOR FOR REVIEW OF INTERLOCUTORY ORDERS**

Petitioner, Pramil S.R.L. (ESAPHARMA), respectfully responds to the Petition filed by the Registrant on August 17, 2005 by mail<sup>1</sup> to the Director for Review of Interlocutory Orders Denying it's Motion for Extension of Testimony Period and for Reconsideration.

On March 28, 2005, the Interlocutory Examiner issued an order denying Registrant's *third* motion for an extension of

<sup>1</sup> Strangely, the Certificate of Service to counsel for Petitioner was dated April 7, 2005.



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it's trial dates. In actuality, this third motion was filed on March 1, 2005 *after* the close of Registrant's testimony period which was set to close on February 28, 2005.

It will be noted that the Registrant in fact took a testimony deposition long after the time for the Registrant to take his testimony had closed, relying on a misguided presumption that the third request would be granted. See §509.02 TBMP which states that when a Motion to reopen is filed, a "party has no right to assume that its motion to extend (much less a motion to reopen made without the consent of the adverse party will always be granted automatically. See *Chesebrough-Pond's Inc. v. Faberge, Inc.* 205 USPQ 888 (CCPA 1980).

By virtue of several granted extensions of time, the Registrant's testimony period was extended to close on February 28, 2005. In fact the testimony submitted by the Registrant was taken on March 29, 2005, one month after the Registrant's testimony period closed.

The third request to extend the testimony period after it had closed was denied by the Interlocutory Attorney in a decision rendered on March 28, 2005.

It should be noted that counsel for the Petitioner did not attend the deposition and in fact had no knowledge of its scheduling was out of the country on business when the late Notice was sent to his Office by facsimile. As noted on page 5 of Petitioner's Response to Registrant's third Request for Extension, counsel for Registrant was fully aware that Petitioner's counsel would be on an extended three week trip beginning on March 12, 2005.

It was clearly careless error for Registrant to assume that it's third request for extension of trial dates would be granted. The Interlocutory Examiner in a well-reasoned decision of July 19, 2005 on Registrant's request for reconsideration, properly applied all of the factors as set forth in *Pioneer Investment Services Company c. Brunswick Associates Ltd. Partnership* 507 U.S. 380 (1993) and held that Registrant's stated reasons for failing to take testimony were not well taken and did not constitute excusable neglect.

One of the key factors in *Pioneer* is the danger of prejudice to the nonmovant. In this case, Petitioner had

already filed it's Brief.<sup>2</sup> If the Registrant were to prevail in this Petition and allowed to use its testimony that was taken by deposition outside of its time window, Petitioner would be denied its basic right to have cross-examined the witness that was deposed. This would be untenable.

As set forth in 37 CFR §2.121(a)(1);

The Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. *No testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board.* (emphasis added)

Clearly here the testimony was improperly taken outside of Registrant's testimony period. A motion to strike is the appropriate remedy here. See TBMP §707.03(b)(1) and such Motion has already been granted.

Registrant has had its day in court and chose not to exercise its right to produce evidence, He should not at this time attempt again to obtain relief by virtue of a Petition to the Director.

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<sup>2</sup> In fact, Registrant has also filed it's Brief and the case is ready for Oral Hearing.

Registrant cites in it's Petition, material from another pending proceeding before the Board which is totally irrelevant to this case. It involves different parties, different issues and a different set of facts. It has clearly no value as a precedent here.

From a procedural point of view, this Petition to the Director should have been filed within thirty days of the mailing of the order from which relief is requested. 37 CFR §2.146(e)(2). The original Order of the Board was mailed on March 28, 2005 denying the Motion to Reopen the Testimony Period. This Petition was filed on August 17, 2005, nearly five months after the order.

Accordingly, the Petition should be denied and the case immediately set for oral hearing as requested by both parties.<sup>3</sup>

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<sup>3</sup>The mere filing of a Petition to the Director will not act as a stay in any proceeding that is pending at the TTAB.

Respectfully submitted,



August 23, 2005

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**CERTIFICATE OF SERVICE**

I certify that a copy of the above Petitioner's Response to Registrant Petition to the Director was served by first class mail with proper postage affixed this 23rd day of August, 2005 on counsel for Registrant, David M. Rogero, Esq., 2600 Douglas Road, Suite 600, Coral Gables, FL 33134.



Donald L. Dennison